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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,136	10/20/2003	Kevin G. Woodruff	030679	3888

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EXAMINER

HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3691

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/689,136	WOODRUFF ET AL.	
	Examiner	Art Unit	
	Lalita M. Hamilton	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>105 Requirement</u> . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-39 are rejected for the following reasons:

In claims 1, 29, and 38, it is unclear what the outcome will be; it is unclear how the call option is obtained; and it is unclear how the forward contract is issued.

In claim 28, it is unclear what the outcome will be.

In claim 30, it is unclear what the outcome will be and how the transaction between the first entity and second entity is structured.

The remaining claims are rejected for their dependency upon the rejected claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-39 are rejected for the following reasons:

In claims 1, 28-30, and 38, the claimed invention is directed to non-statutory subject matter. The subject matter as claimed does not appear to be useful or tangible. In claims 1, 28-30, and 38, it is unclear what the outcome will be. In claims 1, 29, and 38, it is unclear how the call option is obtained and how the forward contract is issued. In claim 30, it is unclear how the transaction between the first entity and the second entity is structured.

The remaining claims are rejected for their dependency upon rejected claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Pushka (2002/0103852).

Pushka discloses a method and corresponding system and computer program for optimizing investment performance comprising obtaining a call option from a second entity, wherein the call option includes a first maturity date; and issuing a forward contract to the second entity, wherein the forward contract includes a second maturity date (p.2, 17-27 and p.6, 114 to p.8, 133); the first entity includes at least one of a financial entity and a business entity (p.2, 17-27 and p.6, 114 to p.8, 133); the second entity includes at least one of a financial entity and a business entity (p.2, 17-27 and p.6, 114 to p.8, 133); the second maturity date is after the first maturity date (p.2, 17-27 and p.6, 114 to p.8, 133); the second maturity date is before the first maturity date (p.2, 17-27 and p.6, 114 to p.8, 133); the second maturity date is the same as the first maturity date (p.2, 17-27 and p.6, 114 to p.8, 133); the forward contract includes an obligation to transfer to the second entity at least one of dividends and distributions on a number of shares of stock of the second entity underlying the forward contract (p.2, 17-27; p.6, 114 to p.8, 133; and p.10, 166); the second entity pays a premium for the

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forward contract (p.2, 17-27 and p.6, 114 to p.8, 133); transferring the at least one of dividends and distributions occurs at maturity of the forward contract (p.2, 17-27; p.6, 114 to p.8, 133; p.10, 166); transferring the at least one of dividends and distributions occurs before maturity of the forward contract (p.2, 17-27; p.6, 114 to p.8, 13; and p.10, 166); transferring the at least one of dividends and distributions occurs after maturity of the forward contract (p.2, 17-27; p.6, 114 to p.8, 133; p.10, 166); total shares outstanding of the second entity are reduced by the number of shares of stock of the second entity underlying the forward contract (p.2, 17-27 and p.6, 114 to p.8, 133); transferring the at least one of dividends and distributions causes at least one of income of the second entity to remain substantially constant and earnings-per-share of the second entity to increase (p.2, 17-27 and p.6, 114 to p.8, 133); the forward contract includes no obligation to transfer to the second entity at least one of dividends and distributions on a number of shares of stock of the second entity underlying the forward contract (p.2, 17-27 and p.6, 114 to p.8, 133); total shares outstanding of the second entity are reduced by the number of shares of stock of the second entity underlying the forward contract (p.2, 17-27 and p.6, 114 to p.8, 133); transferring the at least one of dividends and distributions causes at least one of income of the second entity to decrease and earnings-per-share of the second entity to remain substantially constant (p.2, 17-27 and p.6, 114 to p.8, 133); total shares outstanding of the second entity are reduced by a number of shares of stock of the second entity underlying the forward contract (p.2, 17-27 and p.6, 114 to p.8, 133); the call option includes a provision for assignment of the call option (p.2, 17-27 and p.6, 114 to p.8, 133); the forward contract

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includes a provision for assignment of the forward contract (p.2, 17-27 and p.6, 114 to p.8, 133); at least one of the call option and the forward contract provides a return to the second entity, wherein the return is substantially equivalent to tax-free interest (p.2, 17-27 and p.6, 114 to p.8, 133); first entity assumes the risk associated with at least one of the forward contract and the call option (p.2, 17-27 and p.6, 114 to p.8, 133); the second entity assumes the risk associated with at least one of the forward contract and the call option (p.2, 17-27 and p.6, 114 to p.8, 133); the first entity exercises the call option at maturity (p.2, 17-27 and p.6, 114 to p.8, 133); the first entity does not exercise the call option (p.2, 17-27 and p.6, 114 to p.8, 133); pricing at least one of the forward contract and the call option (p.2, 17-27 and p.6, 114 to p.8, 133); first entity and the second entity enter into the forward contract and the call option simultaneously (p.2, 17-27 and p.6, 114 to p.8, 133); and the first entity and the second entity first enter into one of the forward contract and the call option (p.2, 17-27 and p.6, 114 to p.8, 133).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kalinowski Alexander can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to be 'LH' with a stylized flourish extending to the right.

Lalita M. Hamilton
Primary Examiner, 3691

Serial Number 10/689,136
Art Unit 3691

Requirement for Information Under 37 C.F.R. § 1.105

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

2. In view of the nature of Applicant's assertions and submissions filed October 20, 2003, a question of public use under 35 U.S.C. 102(b) is raised.

Applicant is hereby requested to submit all evidence regarding the use of the claimed invention.

In response to this requirement, please provide:

1) the dates and the extent to which the claimed invention was put into use by the Applicant and to demonstrate with any relevant documentation, specifically, that the use is experimental and not subject to the 35 USC 102(b) statutory bar for public use more than one year prior to the date of filing of the Application.

2) the citation and a copy of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter.

3) the names of any products or services that have incorporated the claimed subject matter

3. The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

4. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the

requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

5. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

6. This requirement is an attachment of the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is THREE months.